

REMARKS

Initially, in the Office Action dated November 5, 2003, the Examiner rejects claims 1-3, 6, 9, 10, 12-14, 18, 20, 21, 26 and 27 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,108,540 (Sonti et al.) in view of U.S. Patent No. 6,223,053 (Friedmann et al.) and further in view of U.S. Patent No 6,317,593 (Vossler). Claims 4, 5, 7, 8, 11, 15-17, 19, 23-25 and 28-30 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sonti et al. in view of Friedmann et al. and further in view of U.S. Patent No. 5,933,778 (Buhrmann et al.). Claim 22 has been rejected 35 U.S.C. §103(a) as being unpatentable Sonti et al. in view of Friedmann et al. and further in view of U.S. Patent No. 4,914,686 (Hagar et al.).

By the present response, Applicants have canceled claims 22-27 without disclaimer. Moreover, Applicants have amended claims 1, 2, 4-9, 11-13, 17, 18, 20, 28-30 and 33-48 to further clarify the invention. Claims 1-21 and 28-49 remain pending in the present application.

Response to Arguments

The Examiner provides a dictionary definition of "sensing" as "to become aware of; perceive". Applicants do not disagree with this definition. However, this does not support the Examiner's assertion that manual dialing is sensing. Manual dialing is an active asserted action. One must physically take a finger or other item and actively press a button or move an apparatus to manually dial. In contrast, sensing is a passive operation. Sensing includes no active initiation or action.

Therefore, manually dialing as disclosed in Sonti et al. is not sensing, as is recited in the claims of the present application. The fact that in Sonti et al., the system becomes aware of a user made selection after the manual dialing still does not disclose or suggest sensing.

Moreover, the Examiner provides a dictionary definition of "configuration" as "arrangement of parts or elements". Again, Applicants do not disagree with this dictionary definition of this single word. However, this does nothing to support the Examiner's assertion that Friedmann et al. discloses selecting automatically a set of communication parameters. Friedmann et al. does not relate to the selection of subscriber profiles, but instead is concerned with a "universal radio" which has the capability to operate in communication systems that employ different radio technologies (DS, FH or hybrid DS-FH spread spectrum systems). Thus, the communication parameters selected automatically by Friedmann et al.'s universal radio do not relate to communication services, as recited in the claims of the present application (e.g., voice, fax and SMS services), but relate to technical parameters which must be set in the radio in order to enable it to communicate with the network.

The Examiner further asserts that Friedmann et al. discloses configurations related to a particular subscriber at col. 5, lines 56-59. However, this portion of Friedmann et al. merely discloses that a user is able to adjust the communication parameters of the radio based on the particular cellular communication system in which the mobile terminal will be used. This is not configurations related to the

particular subscriber, as recited in the claims of the present application. These are parameters related to the communication system.

Further, the Examiner asserts that Friedmann et al. discloses predefined criteria definable by a service provider in Fig. 3 and that Sonti et al. discloses a predefined criterion defined by a subscriber at col. 6, lines 5-8. However, Fig. 3 in Friedmann et al. merely discloses a look-up table with a list of communication parameters for various different cellular communication systems. Further, this portion of Sonti et al. merely discloses the name of a book on wireless cellular communication networks. Applicants submit that these portions of Friedmann et al. and Sonti et al. do not disclose or suggest anything related to predefined criterion being definable by a service provider or by a subscriber, as recited in the claims of the present application.

35 U.S.C. §103 Rejections

Claims 1-3, 6, 9, 10, 12-14, 18, 20, 21, 26 and 27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sonti et al. in view of Friedmann et al. and further in view of Vossler. Claims 26 and 27 have been canceled. Applicants reassert all arguments submitted in response to these rejections in Applicants' previously-filed response. Applicants have discussed the deficiencies of Sonti et al. and Friedmann et al. previously. Applicants respectfully traverse these rejections and provide the following additional remarks.

Vossler discloses a programmable cellular telephone that activates selected functions based on a user modifiable schedule. The user stores schedule

information in a schedule table for automatic function activation/deactivation. A controller controls all cellular telephone functions and a memory and a clock. The controller also includes an automatic scheduler which activates and deactivates cellular telephone functions according to the entries in the schedule table. Cellular telephone functions are activated and deactivated either manually or when the automatic scheduler is enabled and the real time corresponds with the scheduled time in the schedule table.

Regarding claims 1 and 18, Applicants submit that none of the cited references, taken alone or in any proper combination, disclose, suggest or render obvious the limitations in the combination of each of these claims of, inter alia, defining a set of profiles for the subscriber, each profile defining a set of communication services from amongst a plurality of communication services available within the communication system, choosing a particular one of the set of profiles automatically in dependence on a predefined criterion definable by the subscriber or a service provider of the communication system, registering the chosen profile as the profile used to define a current configuration of communication services available to the subscriber, where the predefined criterion defines a condition under which the particular one of the set of profiles is to be registered as the profile used to define the current configuration of communication services available to the subscriber. Sonti et al. merely discloses that a subscriber may select a new profile by dialing a profile number followed by a personal identification number and a new profile number. As has been noted here and in Applicants' previously-filed

responses, in Sonti et al., the subscriber manually dials in information to change a profile. This is not choosing a particular one of a set of profiles automatically in dependence on a predefined criterion definable by the subscriber or service provider of the communication system, as recited in the claims of the present application. The selection of profiles in Sonti et al. is a manual operation. Moreover, the manual selection disclosed in Sonti et al. is not dependent on a predefined criterion. Further, Sonti et al. does not disclose or suggest a predefined criterion definable by the subscriber or service provider, as recited in the claims of the present application.

The Examiner admits that Sonti et al. does not disclose or suggest choosing being automatically, but again asserts that Friedmann et al. discloses these limitations at col. 3, lines 51-58. However, as was fully discussed in Applicants' previously-filed response, Friedmann et al. merely discloses measuring the RSSI of each band, comparing them, checking a RSSI threshold, and using the band with the greatest RSSI if it exceeds the threshold. The parameters in Friedmann et al. are all related to different cellular communication systems (see col. 7, lines 20-29), and are not a set of profiles or a set of profiles for a subscriber, as recited in the claims of the present application. Moreover, Friedmann et al. discloses the threshold parameter being a fixed value (see col. 24, lines 53-55). This is not a predefined criterion definable by the subscriber or a service provider where the predefined criterion defines a condition under which the particular one of the set of profiles is to be registered as the profile used to define the current configuration communication services available to the subscriber, as recited in the claims of the present

application. Further, Vossler does not disclose or suggest any of these limitations as recited in the claims of the present application.

Regarding claims 2, 3, 6, 9, 10, 12-14, 20, 21 and 31-48, Applicants submit that these claims are dependent on one of independent claims 1 and 18 and, therefore, are patentable at least for the same reasons noted regarding these independent claims. For example, Applicants submit that none of the cited references disclose or suggest a predetermined profile being designated to be registered in the event that none of the set of profiles meets a predefined criterion, or where the predefined criterion is a location-dependent criterion and choosing a particular one of the set of profiles is performed automatically in dependence on the location-dependent criterion, or where if an attempt is made to override a profile chosen automatically to select or register a particular profile different from the profile chosen automatically, a check is performed to determine if selection or registration of said particular profile is forbidden, whereupon if selection or registration of said particular profile is forbidden, its selection or registration is prevented..

Accordingly, Applicants submit that none of the cited references taken alone or in any proper combination, disclose, suggest or render obvious the limitations in the combination of each of claims 1-3, 6, 9, 10, 12-14, 18, 20, 21 and 31-48 of the present application. Applicants respectfully request that these rejections be withdrawn and that these claims be allowed.

Claims 4, 5, 7, 8, 11, 15-17, 19, 23-25 and 28-30 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sonti et al. in view of Friedmann et al.

and further in view of Buhrmann et al. Applicants reassert all arguments submitted against these rejections filed in Applicants' previously-filed response. Applicants have canceled claims 24 and 25.

Regarding claims 4, 5, 7, 8, 11, 15-17, 19 and 28-30, Applicants submit that these claims are dependent on one of independent claims 1 and 18 and, therefore, are patentable at least for the same reasons noted regarding these independent claims. Applicants submit that Buhrmann et al. does not overcome the substantial defects noted previously regarding Sonti et al. and Friedmann et al. For example, Applicants submit that none of the cited references disclose or suggest checking the choice of registered profile each time a call is made, or the set of profiles being ranked in order of priority such that one of relatively higher priority which satisfies the predefined criterion is used before one of relatively lower priority which also satisfies the predefined criterion.

Accordingly, Applicants submit that none of the cited references, taken alone or in any proper combination, disclose, suggest or render obvious the limitations in the combination of each of claims 4, 5, 7, 8, 11, 15-17, 19 and 28-30 of the present application. Applicants respectfully request that these rejections be withdrawn and that these claims be allowed.

Claim 22 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Sonti et al. in view of Friedmann et al. and further in view of Hagar et al. Applicants have canceled this claim therefore rendering this rejection moot.

Unexamined claims

Applicants assert that this is an improper Office Action in that the Examiner has failed to examine claims 31-49 added in Applicants' previously-filed response. Claims 31-48 are dependent on one of independent claims 1 and 18, as has been discussed previously, and are patentable at least for the same reasons noted regarding these independent claims.

Regarding claim 49, Applicants submit that, as has been noted previously, none of the cited references disclose or suggest sensing an external parameter, or determining if a sensed external parameter relates to any forbidden configurations of communication services, or choosing a configuration of communication services not forbidden from a plurality of configurations where the choosing is performed automatically in dependence on the sensed external parameter meeting a predefined criterion. As has been noted previously, none of the cited references disclose or suggest sensing, a predefined criterion, or choosing a profile or configuration of communication services automatically based on a sensed external parameter meeting a predefined criterion. Moreover, none of the cited references disclose or suggest anything related to a configuration of communication services not forbidden from a plurality of configurations, as recited in the claims of the present application.

Accordingly, Applicants submit that claims 21-49 are patentable over the cited art, taken alone or in any proper combination, and respectfully request that the Examiner examine these claims before any subsequent Office Action.

U.S. Application No. 09/416,526

In view of the foregoing amendments and remarks, Applicants submit that claims 1-21 and 28-49 are now in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (referencing attorney docket no. 367.37732CX1).

Respectfully submitted,

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